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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/542,574

07/19/2005

Volkmar Menger

12810-00111-US

6965

23416

7590

05/12/2008

CONNOLLY BOVE LODGE & HUTZ, LLP

P O BOX 2207

WILMINGTON, DE 19899

EXAMINER

SMITH, JENNIFER A

ART UNIT

PAPER NUMBER

1793

MAIL DATE

DELIVERY MODE

05/12/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/542,574	<b>Applicant(s)</b> MENER ET AL.	
	<b>Examiner</b> JENNIFER A. SMITH	<b>Art Unit</b> 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-2, 4-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4 and 5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Status of Application***

Claim 3 is canceled.

No claims have been amended.

Claims 1-2 and 4-5 are rejected.

### ***Withdrawal of Objections to Specification***

The objections to the specification have been withdrawn in view of Applicant's arguments.

### ***Withdrawal of Claim Rejections - 35 USC § 112 – 2<sup>nd</sup> Paragraph***

The rejections of claims 1, 2, 4, and 5 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention have been withdrawn in view of Applicant's argument. The claims have been given their broadest reasonable interpretation in light of the supporting disclosure. Applicant references page 2, lines 12-20 of the specification describing the process of "working up" to mean "cleaning of an exhausted or deactivated catalyst to allow disposal".

***Claim Rejections - 35 USC § 103***

Claims 1-2 and 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mueller et al. US Patent No. 4,480,124 in view of Menger et al. US Patent No. 6,713,422 B1.

Claims 1-2 and 4-5 are rejected on the same grounds as stated in the Office Action of December 28, 2007.

***Response to Arguments***

Applicant's arguments filed 02/19/2008 have been fully considered but they are not persuasive.

First, Applicant argues that the Mueller reference cannot be modified by the Menger reference as suggested (replacing hydrogen with water steam) because the proposed modification would render Mueller unsatisfactory for its intended purpose because the intended purpose of Mueller of obtaining a low color number in the purification of polytetramethylene ether glycol could no longer be achieved. The combination of the Mueller reference with the Menger reference would not make the process inoperable. Menger teaches cleaning a deactivated catalyst with steam [See Claim 1] and the function of the catalyst for hydrogenation is not negatively affected by the use of steam (in a separate and unrelated step) to purify the deactivated catalyst.

Second, Applicant argues that the Mueller reference is directed to an industrial process for the production of PTHF and the Menger reference suggests a process for working up at least a partially deactivated polymerization catalyst and they do not suggest features that can reasonably be considered to correspond to a working up of the metal hydrogenation catalysts. In response to applicant's argument it is maintained that the Mueller and Menger references are considered to be in the field of applicant's endeavor and reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention (namely the cleaning of a deactivated hydrogenation catalyst). See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Mueller discloses a process for the use of a dehydrogenation catalyst and Menger teaches the purification of polytetramethylene ether glycol *in the presence of a hydrogen catalyst*. One would have been motivated to combine the subjects taught by the two references because the catalyst used in color number hydrogenation (in the Mueller reference) would be deactivated or partially deactivated in the process. The purification process taught in the Menger reference would predictably yield a catalyst free of pollutants [See Menger, Column 1, line 45].

### ***Conclusion***

Claims 1-2 and 4-5 are rejected

No claims are allowed.

Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JENNIFER A. SMITH whose telephone number is (571)270-3599. The examiner can normally be reached on Monday - Friday, 8:30am to 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571)272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1793

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Roy King/  
Supervisory Patent Examiner, Art  
Unit 1793

Jennifer A. Smith  
May 1, 2008  
Art Unit 1793

JS